REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 8, 10, 11, 13-17, 23, 24, 30, 32, 33, 35-39, 45-48, and 50-52 are currently pending. Claims 3-7, 9, 12, 18-22, 25-29, 31, 34, 40-44, 49, and 53 have been canceled without prejudice; and Claims 1, 13-15, 23, and 35-37 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-4, 8-10, 12-15, 23-26, 31, 32, 34-37, 45, 46, 48, and 50-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,219,694 to Lazaridis et al. (hereinafter "the '694 patent") in view of U.S. Patent No. 6,522,421 to Chapman et al. (hereinafter "the '421 patent"); Claims 5-7, 11, 16, 17, 27-29, 30, 33, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '694 and '421 patents, further in view of U.S. Patent No. 5,951,636 to Zerber (hereinafter "the '636 patent"); Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the '694 and '421 patents, further in view of U.S. Patent No. 6,108,492 to Miyachi (hereinafter "the '492 patent"); Claims 18, 40, 49, and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '492 patent in view of U.S. Patent No. 5,412,779 to Motoyama (hereinafter "the '779 patent"); and Claims 19-22 and 41-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '492 and '779 patents, further in view of the '694 patent.

Applicants wish to thank the Examiner for the interview granted Applicants' representative on May 9, 2007, at which time the outstanding rejection of the claims was discussed. However, no agreement on the patentability of the claims was reached pending

the Examiner's further consideration of the claims upon formal submission of a response to the outstanding Office Action.

Applicants respectfully submit the rejections of Claims 3-7, 9, 12, 18-22, 25-29, 31, 34, 40-44, 49, and 53 are rendered moot by the present cancellation of those claims.

Amended Claim 1 is directed to a method of processing messages, comprising: (1) receiving an electronic mail message by a computer; (2) determining, by the computer, whether a content of the received message is (a) intended to be read or viewed by a user, or (b) provides an instruction to an attached printing device associated with the computer by detecting a characteristic of the message, wherein the received message does not include print data to be printed by the attached printing device and the instruction is unrelated to printing of data included in or attached to the received message, the attached device including a processor; (3) transmitting a communication from the computer to the attached printing device, if the determining step determines that the received message provides the instruction to the attached printing device; and (4) operating the processor of the attached printing device in response to the transmitted communication. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.[1]

As discussed above, Claim 1 finds general support in the flowchart of Figure 14 and pages 26-28 in the specification. In addition, the receiving step recited in Claim 1 is supported by Figure 14, step 520. The determining step recited in Claim 1 is supported by Figure 14, steps 524 and 526. Further, the transmitting and operating steps recited in Claim 14 are supported by Figure 14, step 528 and the discussion related thereto in the specification.

Independent Claim 23 sets forth a system reciting limitations analogous to the limitations recited in Claim 1 and is supported by the originally filed specification and drawings in a manner analogous to the support for Claim 1 described above. In addition,

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[1] See, e.g., Figure 14 and the discussion related thereto in the specification, e.g., pages 26-28.

support for the system components recited in Claim 23 is provided by Figures 8-10 and the discussion related thereto in the specification.

Applicants respectfully submit that the rejection of Claim 1 under 35 U.S.C. § 103 is rendered moot by the present amendment to Claim 1.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103, the Office Action asserts that the '694 patent discloses everything in Claim 1 with the exception of "an e-mail message that contains an instruction for controlling/monitoring of a printer," and relies on the '421 patent to remedy that deficiency.

The '694 patent is directed to a system and method for pushing information from a host system to a mobile communication device having a shared electronic address with the host system. As shown in Figure 1, the '694 patent discloses a system in which certain user-defined event triggers are activated and messages or commands are redirected from a desktop computer to a mobile communication device. In particular, as shown in steps 68-72 of Figure 4, regarding incoming e-mail messages, if the messages are to be redirected by the redirector 12, the message is repackaged by placing an outer wrapper around the original message before being forwarded to the user.[2] Further, the '694 patent discloses that if the redirector is configured so that the mobile data device cannot receive and process word processor or voice attachments, then the redirector routes these attachments to an external machine that is compatible with a particular attachment, such as an attached printer, network fax machine, or telephone.[3] However, Applicants note that the '694 patent discloses that all of the e-mail messages that are redirected by the redirection software 12 are intended to be read or viewed by a user, even if some of the attachments are first printed by a printer before being viewed by a user.

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[2] See, e.g., the '694 patent, column 10, line 39 - column 11, line 5.
[3] See, e.g., the '694 patent, column 3, lines 48-54.

However, Applicants respectfully submit that the '694 patent fails to disclose the step of determining, by the computer, whether a content of the received message is (1) intended to be read or viewed by a user, or (2) provides an instruction to an attached printing device associated with the computer by detecting a characteristic of the message, wherein the received message does not include print data to be printed by the attached printing device and the instruction is unrelated to printing of data included in or attached to the received message, as recited in amended Claim 1. Regarding sending an attachment to an attached printing device, the received messages in the '694 patent are limited to messages that contain print data to be printed by a printer and any associated instructions (not explicitly disclosed) for printing the attached data file. However, amended Claim 1 is directed to messages that <u>do not include print data to be printed by the attached printing device</u> and <u>any instructions are unrelated to printing of data included in or attached to the received message</u>. Rather, Claim 1 is directed to determining whether the content of the received message is intended to be read or viewed by a user, or provides an instruction (unrelated to printing of data included in or attached to a received message) to an attached printing device associated with the computer.

The '421 patent is directed to a method of automatically communicating status information *relative to a document production job* by a printer, including the steps of creating a page description language file with embedded e-mail information, sending the <u>page description language file</u> to the printer, having the printer detect the embedded e-mail information, having the printer print the print job, and having the printer send status information via e-mail *regarding the print job* to the embedded e-mail address. However, Applicants respectfully submit that the '421 patent fails to disclose the step of <u>determining, by the computer, whether a content of the received message is intended to be read or viewed by a user, or provides an instruction to an attached printing device associated with the computer</u> by detecting the characteristic of the message, <u>wherein the received message does</u>

not include print data to be printed by the attached printing device and the instruction is unrelated to printing of data included in or attached to the received message, as recited in amended Claim 1. On the contrary, the '421 patent discloses that the embedded e-mail address is related to the reporting of the status of the print job in which the e-mail address is embedded. Further, the message disclosed by the '421 patent is in the form of a page description language file, not an e-mail. Moreover, the information received by the printer in the '421 patent includes print data, and even if the e-mail embedded in the print data can be interpreted as an instruction, this "instruction" is related to printing of data included in or attached to the received message, contrary to the limitations recited in amended Claim 1.

Accordingly, no matter how the teachings of the '694 and '421 patents are combined, the combination does not teach or suggest determining, by a computer, whether a content of a received message is (1) intended to be read or viewed by the user, or (2) provides an instruction to an attached printing device associated with the computer by detecting the characteristics of the message, wherein the received message does not include print data to be printed by the attached printing device and the instruction is unrelated to printing of data included in or attached to the received message, as recited in amended Claim 1.

Accordingly, Applicants respectfully submit that amended Claim 1 (and all similarly rejected dependent claims) patentably defines over any proper combination of the '694 and '421 patents.

Independent Claim 23 recites limitations analogous to the limitations recited in Claim 1. Moreover, Claim 23 has been amended in a manner analogous to the amendment to Claim 1. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejection of Claim 23 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 23.

Regarding the rejection of Claims 11, 16, 17, 30, 33, 38, and 39 under 35 U.S.C. § 103, Applicants respectfully submit that the '636 patent fail to remedy the deficiencies of the '694 and '421 patents, as discussed above. Accordingly, Applicants respectfully submit that the rejection of Claims 11, 16, 17, 30, 33, 38, and 39 are rendered moot by the present amendment to the independent claims.

Applicants respectfully submit that the rejection of Claim 47 is rendered moot by the present amendment to the independent claims.
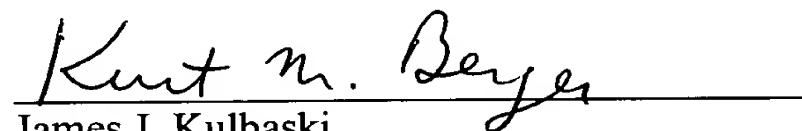
Applicants respectfully submit that the rejection of Claims 18-22, 40-44, 49, and 53 are rendered moot by the present cancellation of those claims.

Thus, it is respectfully submitted that independent Claims 1 and 23 (and all associated dependent claims) patentably define over any proper combination of the '694, '421, '636, '779, and '492 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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15